

ELECTION WITH TRAVERSE

The Examiner has restricted prosecution of the claims and required election of one of three groups: Group I including claims 1-6 and 12-16; Group II including claims 7-11; and Group III including claims 17-19.

The Examiner states that the claims of the groups claim distinct inventions because Inventions I and II are related as combination and subcombination in that subcombination of Group II has separate utility such as for occluding a blood vessel. The applicant has amended claim 7 of Group II to remove the separate utility of occluding a blood vessel. Thus, claims 7-11 as amended now relate closely to claims 1-6 and 12-16 and do not present a combination/subcombination. It is respectfully requested that the Examiner reconsider the restriction requirement with respect to Groups I and II in light of such amendment.

The Examiner also states that the claims of Group I, II and III are related as products and process of use and that the products as claimed can be used in a materially different process such as in a procedure for occluding a blood vessel as the plug device could be used to stop blood flow or close an opening such as a shunt in the heart. The applicant respectfully traverses this argument for the following reasons. First, the plug device claimed in the method claims relates very directly and specifically to the plug device claimed in the apparatus claims. The claims (as amended) are all directed to a plug device of a size between 1.0mm and 2.5mm which is specifically directed to

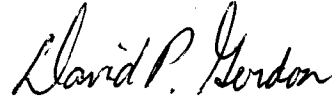
plugging a uterine tube. With the size limitation provided in the apparatus claims, and with the language limitations directed to “a device for occluding a uterine tube portion” where the device has a “diameter of between 1.0mm and 2.5mm but greater than the interior diameter of the uterine tube portion”, what is claimed in claims 1-16 as amended cannot be stated to be a plug that can be used for any purpose other than occluding a uterine tube portion. Thus, the claims of Groups I, II and III are not distinct.

Second, it is respectfully submitted that the Examiner's position regarding restriction/election is incorrect. 35 U.S.C. 121 provides for restriction when “two or more independent **and** distinct inventions are claimed in the same application”. As set forth in MPEP 802.01, the term "independent" means that there is no disclosed relationship between the subjects, i.e., they are unconnected in design, operation or effect. It is readily apparent that in the present application the method claims of Group III are closely connected in design, operation and effect to the apparatus claims of Groups I and II. The Examiner has argued that the claims are "distinct" (which is refuted above) but not that they are "independent". The statute requires that they be both independent and distinct before restriction is allowed. In re Harnisch, 206 U.S.P.Q. 300 at 306 (C.C.P.A. 1980). If the MPEP states the contrary, the statute is controlling. New South Industries, Inc. v. Apache Grounding Corporation, 4 U.S.P.Q.2d 1890 (M.D. Tenn. 1987) and In re Weber et al., 198 U.S.P.Q. 328 at 333 n. 2 (C.C.P.A. 1978).

For purposes of responsiveness, the applicant elects with traverse to prosecute Group III, claims 17-19. However, given the above analysis, the applicant respectfully

requests that the restriction requirement be reconsidered and dropped, and that all of the claims be examined.

Respectfully submitted,

A handwritten signature in black ink that reads "David P. Gordon". The signature is written in a cursive style with a large, stylized "D" and "G".

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